

Trial Section Merits Panel and is not binding precedent of the Board.
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Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

WILLIAM J. RUTTER
and HOWARD M. GOODMAN
(4,935,235 and 5,196,194),

Junior Party,

v.

KENNETH MURRAY
(08/472,301, 08/480,118,
and 08/486,592),

Senior Party.

Interference No. 104,031

Before SCHAFER, LEE, and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

JUDGMENT AND RECOMMENDATION

(PURSUANT TO 37 CFR §§ 1.640 AND 1.659(c))

INTRODUCTION

The parties contend that there exists no interference-in-fact between the subject matter of the claims involved in the

interference because Rutter's species are not obvious in view of Murray's genus. This contention is consistent with a determination in a previous interference (101,793) that the species is separately patentable from the genus. It is also consistent with a statement in the examiner's statement under 37 CFR § 1.609 that "The Murray invention does not anticipate nor render obvious that of Rutter et al." Based on these facts, the present interference cannot be maintained. Nevertheless, questions involving the patentability of Murray's claims were raised (see Paper No. 2) and persist in the face of the responses from the parties (see Paper No. 22). Consequently, a recommendation under 37 CFR § 1.659(c) is appropriate.

ORDER

Upon consideration of the record of this interference, it is

ORDERED that judgment be awarded to both parties; and

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative record of each of Rutter's involved patents and Murray's involved applications; and it is

RECOMMENDED that the examiner on assuming jurisdiction over the Murray applications consider

the applicability of interference estoppel as explained
in Paper Nos. 2 and 22,
the terminal disclaimers proffered in Paper No. 20 at 5-6
in response to Paper No. 2, part C, and
the amendments proffered with Paper No. 20 in response to
Paper No. 2, part E.

RICHARD E. SCHAFER
Administrative Patent Judge

JAMESON LEE
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

BOARD OF
PATENT
APPEALS AND
INTERFERENCES

Interference No. 104,031
Rutter v. Murray

Paper No. 23
Page 4

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Boehringer
Mannheim GmbH; Green Cross; Roche Diagnostic Systems, Inc.;
Wellcome (Murex), Murex Diagnostics Ltd.; Dako Corporation;
Organon Teknika B.V.; Sorin Biomedica S.p.A.; Radim s.p.a.;
Kodak Clinical Diagnostics Ltd.; J & J Clinical Diagnostics
Ltd.; Biotrack, Inc.; BioMerieux; Chiron Corporation; Pasteur
Sanofi Diagnostics; F. Hoffmann LaRoche Diagnostics; Immuno
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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Board of Patent Appeals and Interferences
Interference Trial Section

12 December 2001 - 16.53

TO: Yolunda R. Townes
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FROM: Richard Torczon

INTERFERENCE NO. 104,031

9 Please review the attachment and, if no corrections are necessary, please circulate as indicated.

9 If corrections are necessary, please mark the attachment accordingly and return it to me.

Thank you for your assistance in this matter.

Attachment

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